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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,189	04/11/2001	Katsuhiko Mikoshiba	04853.0068	1135

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EXAMINER

TURNER, SHARON L

ART UNIT PAPER NUMBER

1647

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/832,189	Applicant(s) MIKOSHIBA ET AL.	
	Examiner Sharon L. Turner	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-25-01, 10-30-03</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS 12-23-03</u>                       |

## **DETAILED ACTION**

### **Sequence Requirements**

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

In particular, Figures 1 and 2 lack proper sequence data for the sequences represented in the figures.

### **Specification and Drawings**

2. The specification and drawings are objected to because both the figure legends and drawings lack appropriate reference to sequences contained within the Figures by SEQ ID NO:. In addition, the figure legends within the specification should be amended to refer to the representative views, i.e., Figures 1A-1B, 5A-5F, 6A-6C. A proposed drawing correction, corrected drawings and/or amendment of the specification are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Applicants may alternatively choose to amend the specification so as to refer to the appropriate sequences within the figures by their SEQ ID NO:.

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3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### **Election/Restriction**

4. Applicant's election with traverse of Group I, claims 1-2 drawn to the peptide of mouse truncated Reelin protein comprising an F-spondin domain and a CR-50 recognition site of a Reelin protein but containing no repeat site, in the Paper of 2-20-04 is acknowledged. The traversal is on the ground(s) that the election should be a species election requirement and not a restriction requirement, that there is no burden and that the searches should be identical. This is not found persuasive because the elements of the claims define unique sequence elements that are derived from different sources and have different structures, functions and effects, for example as evidenced by their distinct language, SEQ ID NO's, and species of origin and therefore the searches are not co-extensive, present burden and are patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

5. Claims 3-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Paper of 2-20-04.

#### ***Double Patenting***

6. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619

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(CCPA 1970); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 09/897,438. Although the conflicting claims are not identical, they are not patentably distinct from each other. In particular, instant claims and '438 claims overlap in that each represents a truncated Reelin protein comprising a CR-50 epitope region (antibody recognition site). The claims are both recited in open language and differ only in that the instant claims also comprise a F-spondin domain, both peptides being deleted in the repeat site. To the extent that the other patent also teaches Reelin proteins with the noted three regions, the truncated variants appear to be obvious variants in that they each share a same core structure (CR-50) antibody recognition site and function in promoting antibody reactivity. Both peptides are the products of truncating Reelin peptide. Thus, the patenting of the co-pending claims would appear to render obvious the instantly claimed invention. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Arcangelo et al., J. of Neurosci., 17(1):23-31, 01 January, 1997 as further evidenced by D'Arcangelo et al., Nature 374:719-723, 20 April, 1995, both IDS references of disclosure 10-25-01.

D'Arcangelo et al., teach mouse Reelin deletion mutants pCr1462 and pCr1407 that comprise an F-spondin domain comprised within residues 1-190 and a CR-50 recognition site mapped to positions within residues 251-407. The mutants are also noted to lack any EGF repeat sites as noted in Figure 1. D'Arcangelo et al., 1995 further evidence the location of the F-spondin and EGF repeat sites. In particular, the F-spondin region is noted to be at positions 1-190 and the 8 EGF repeat sites are noted to start at position 501 and stretch to residue 3426, see in particular Figure 1. Thus, the reference teachings anticipate the claimed invention.

**Status of Claims**

10. No claims are allowed.

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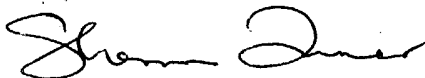
### Conclusion

11. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (571) 272-0894. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached at (571) 272-0887.



Sharon L. Turner, Ph.D.  
May 6, 2004